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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/389,386 09/03/99 IZQUIERDO

P 225/48098

EXAMINER

QM32/0410

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WASHINGTON DC 20005

NOTIFYEN,
ART UNIT

PAPER NUMBER

15

3726
DATE MAILED:

04/10/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/389,386

Applicant(s)

Izquierdo et al.

Examiner

Trinh Nguyen

Group Art Unit

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☒ Responsive to communication(s) filed on Jan 23, 2001

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-4, 10, 11, 15, 16, 18-20, 22 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-4, 10, 11, 15, 16, 18-20, 22 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 13

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-4, 10, 11, 15, 16, 18, 20, and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Palazzolo et al. (US 5,691,004).

Palazzolo et al. teach a method for surface treatment of an interior of a hollow body such as an engine cylinder bore, wherein the method comprising the step of dry-cutting, i.e., honing, milling, drilling, brushing, knurling, and/or abrading, the interior of the hollow body (13) by using a tool (19, 17) to remove a surface material therein.

Regarding claim 4, note in lines 1-20 of col. 3, Palazzolo et al. disclose that the tool can be comprised of any hard material such as boron nitride, coated or uncoated metal, or even diamond.

Regarding claims 10 and 11, note in lines 19-23 of col. 3, Palazzolo et al.'s tool (19) is an indexing insert wherein the tool is fitted with a plurality of indexing inserts (17).

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Regarding claims 16 and 17, note in the Abstract, Palazzolo et al. teach that after the honing/dry-cutting step the interior surface of the hollow body is thermally sprayed with a metallic bond coat.

Regarding claim 22, note in Figure 1, the surface profile of tool (19, 17) is an undefined surface profile.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Palazzolo et al. (US 5,691,004).

With respect to claim 19, Palazzolo et al. disclose the claimed invention except for specifying that "the dry cutting is performed with at most 150 ml/h of lubricant". However, it is the examiner's position that such aforementioned limitation was a matter of design choice, wherein no significant problem is solved or unexpected result obtained, since it being assumed that the ordinary skill artisan would use a best known fabricating technique best suited for a particular application, in order to realize the benefits of obtaining a high quality level of surface treatment effectiveness.

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Response to Arguments

5. Applicant's arguments filed 1/23/01 have been fully considered but they are not persuasive.

6. Applicants argue that Palazzolo does not teach dry cutting, wherein dry cutting means that no lubrication is used or that at most minimum lubrication, the interior of a hollow body. It is noted that the phrase "no lubrication is used or that at most minimum lubrication" can be interpreted as either providing no lubrication at all or providing some sort of lubrication thereof; therefore, it is the Examiner's position to interpret that Palazzolo does disclose dry cutting the interior of a hollow body with some sort of lubrication (see Abstract) and that whether the lubrication is performed at a volume flow of less than 150 ml/h is deemed to be a matter of design choice, since it being assumed that the ordinary skill artisan would use a best known fabricating technique best suited for a particular application in order to realize the benefits of obtaining a high quality level of surface treatment effectiveness.

Conclusion

7. **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Trinh Nguyen** whose telephone number is **(703) 306-9082**.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1148.

TTN

March 26, 2001


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